

## **REMARKS**

Claims 1, 3-7, and 9-20 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 1, 3-6, 9-10, and 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 5,018,060 to Gelb et al. (hereinafter Gelb) in view of United States Patent Number 5,757,571 to Basham et al. (hereinafter Basham). Claims 7, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of United States Patent Application Publication Number 2003/0204672 by Bergsten (hereinafter Bergsten). Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Bergsten and “Active Storage for Large-Scale Data Mining and Multimedia” Proceedings of the 24<sup>th</sup> VLDB Conference, New York, USA, 1998 by Erik Riedel et al. (hereinafter Riedel).

Applicants have added new claims 21-23. The claims are fully supported by the specification, which teaches the pre-defined look-up table. Page 13, ¶ 45. Applicants have also added claim 24. Claim 24 is fully supported by the specification, which teaches the accessor. Page 9, ¶ 32. Claims 6 and 11 are canceled.

### **Response to rejections of claims under 35 U.S.C. § 101**

Claims 1, 3-7, and 9-20 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants have amended claims 1, 4, and 5 with the limitation that each module is “...implemented in software for execution on a processor...” Claims 1, 4, and 5 as amended. The amendment is well supported by the specification, which teaches “Modules may also be

implemented in software for execution by various types of processors.” Page 8, ¶ 27. Applicants submit that as amended claims 1 and 3-5 are directed to a machine, and are therefore allowable under 35 U.S.C. § 101.

Applicants have further amended claim 1 with the limitation “...the storage controller stores the dataset on the magnetic tape storage device in response to the storage instruction.” Claim 1 as amended. Claims 7 and 15 are similarly amended. As amended, claims 1, 7, and 15 are directed to producing the useful and tangible result of storing the dataset to the magnetic tape storage device. Applicants therefore submit that claims 1, 7, and 15 are allowable under 35 U.S.C. § 101, and that claims 3-5, and 9, 10, 12-14, and 16-20 are allowable as depending from allowable claims. Claims 6 and 11 are canceled.

Response to rejections of claims under 35 U.S.C. § 103(a)

Claims 1-6, 8-10, and 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham. Claims 7, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Bergsten. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Bergsten and Riedel. Applicant respectfully traverses these rejections.

Claims 1, 7, and 15 as amended include the limitations “...storage characteristics comprise compaction and media interchange specifications...” and “...select a storage instruction in response to storage criteria applied to the storage characteristics...” Claim 1 as

amended. See also claims 7 and 15. Thus the present invention claims selecting a storage instruction in response to storage criteria applied to storage characteristics comprising compaction and media interchange specifications.

While Basham mentions compaction, neither Basham, Gelb, nor Bergsten teach the limitation of selecting a storage instruction in response to storage criteria applied to storage characteristics comprising compaction and media interchange specification. Basham, col. 5, lines 56-60. Applicants therefore submit that claims 1, 7, and 15 are allowable. Applicants further submit that claims 3-5, and 9, 10, 12-14, and 16-24 are allowable as depending from allowable claims.

Claims 1, 7, and 15 are further amended with the limitation "...select a storage instruction in response to storage criteria applied to the storage characteristics *that indicate scaling is beneficial...*" Claim 1 as amended, emphasis added for amendment. See also claims 7 and 15. The amendment is fully supported by the specification, which discloses "...storage characteristics that indicate storage on a scaled tape storage cartridge 116 is beneficial..." Page 13, ¶ 44.

The amendment differentiates the present invention from Basham. In the office action of November 13, 2006, the Examiner points out that Basham teaches "Until the tape is filled, future data may be stored by creating additional partitions as described above, each partition having a variable size appropriate to the amount of data stored therein;" "an application may require assorted sizes of fixed-size partitions, each partition including one or more adjacent segments, as required by the application;" and "As an example, partition sizes may be established by receiving

user input (not shown) prior to tasks 502 and 604.” Office action of November 13, 2006, page 4, lines 7-13 quoting Basham, col. 3, lines 58-61, col. 11, lines 25-30; col. 11, lines 33-36. The references cited by the Examiner do not teach selecting a storage instruction in response to storage criteria applied to the storage characteristics *that indicate scaling is beneficial*. Instead, the references teach away from scaling when beneficial by teaching storing data until the tape is filled. Applicants therefore submit that claims 1, 7, and 15 are allowable as the cited references do not include all of the elements of the claims, and that claims 3-5, and 9, 10, 12-14, and 16-24 are allowable as depending from allowable claims.

Should additional information be required regarding the traversal of the rejections of the claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

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